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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/049,162

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Nobuchika Hirashima

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09/24/2004

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EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,162

Applicant(s)

HIRASHIMA ET AL.

Examiner

Shian T. Luong

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3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/10/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-13, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP S57-111822 and/or JP S55-134822 and/or JP S56-60730 in view of S61-108257 and Timaiuolo and Haines (US 3,835,995) or Katzner et al. (US 6,155,423). JP S57-111822, JP S55-134822 and JP S56-60730 all disclose of a roll-wound plaster with a medicinal part on the plaster. JP S57-111822 and/or JP S55-134822 and/or JP S56-60730 do not disclose the specific material and tear off cutting lines. S61-108257 discloses a tape-protecting case with left and right covers engaging a core and protecting the side surfaces of adhesive tape. The engaging element is the protrusion shown in Figures 2-3. It would have been obvious to form a roll by winding an adhesive strip around the outside of a core but within the cover to prevent soiling and deformation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cover out of polyacrylonitrile resin and the core out of polyethylene terephthalate resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Tomuiuolo teaches an adhesive bandage on a strip of material. The bandages are separated by perforations or slits. It would have been obvious in view of Tomuiuolo to provide covers attached to the spool to surround the edges of the strip to prevent contamination

Haines or Katzner et al. teaches laminated package with perforation lines. Perforation lines separate the individual units on the package. It would have been obvious in view of Haines or Katzner et al. to provide perforations that extend through the laminated layers to facilitate separation of the units.

3. Claim 18 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 11, further in view of Praneo et al. (US 5,924,573) and Kennedy (US 5,655,659) and Augst et al. (US 5,496,605). The modified reference does not disclose the width and spacing of the perforation slits. But one of ordinary skill in the art would determine the proper width of the slit and the spacing between the slits through routine experiments. Hence, it would have been obvious to provide a width of 1.0-2.0mm and a slit spacing of 1.0-1.5mm and the breaking strength of 7.36-15.24kgf/48 mm width by experimenting different size of cut and location. The slit width and spacing is to facilitate separation of a portion of the tape type support. To make the slit a certain width and to determine the spacing therebetween is an indication of how much effort a user has to assert in order to separate a portion of the tape type support. One of ordinary skill in the art would readily recognize different width and spacing as conventional knowledge to improve the tearing strength required of a user. Piraneo et al., for example, teaches that the slit pattern is selected to allow easy opening and removal of the article. Augst et al. teaches that when the spacing between perforations are too long it is difficult to separate and accidental and unintended separation is likely when the perforations are too short. The reference discussed the right tensile strength should be determined to prevent premature separation and sufficient reduction in tensile strength to ensure easy and consistent separation. Augst et al. achieved the result by considering various

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variable and test the variables. Finally, Kennedy is also cited to show that spacing between perforations is about 1.02mm.

Applicant stated on page 10 of the response that there is no admission of a roll type transdermal patch roll. But in the background art section of page 1, it clearly laid out the external roll out patches as conventionally known in the industry. Hence, it is treated as prior art.

4. Claims 11-16, 19-24, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art on page 1 of the specification in view of Timaiuolo and Haines (US 3,835,995) or Katzner et al. (US 6,155,423). Admitted Prior Art discloses external patch rolls composed of a dispenser core and a strip-like patch wrapped around the outer perimeter side. The external patches are usually constructed with a support made of nonwoven fabric, an adhesive layer laminated on one side thereof and a covering attached to the adhesive layer in a releasable manner. Admitted Prior Art does not disclose two covers adjacent to the roll and the specific material. Tomiuolo teaches an adhesive bandage on a strip of material. The bandages are separated by perforations or slits. It would have been obvious in view of Tomiuolo to provide covers attached to the spool to surround the edges of the strip to prevent contamination. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the side covers out of ployacrylonitrile resin and the core and covering layer out of polyethylene terephthalate resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claim 17-18, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claims 11 and 20, further in view of Praneo et al. (US

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5,924,573) and Kennedy (US 5,655,659) and Augst et al. (US 5,496,605). The modified reference does not disclose the width and spacing of the perforation slits. But one of ordinary skill in the art would determine the proper width of the slit and the spacing between the slits through routine experiments. Hence, it would have been obvious to provide a width of 1.0-2.0mm, a slit spacing of 1.0-1.5mm and the breaking strength of 7.36-15.24kgf/48 mm width by experimenting different size of cut and location. The slit width and spacing is to facilitate separation of a portion of the tape type support. To make the slit a certain width and to determine the spacing therebetween is an indication of how much effort a user has to assert in order to separate a portion of the tape type support. One of ordinary skill in the art would readily recognize different width and spacing as conventional knowledge to improve the tearing strength required of a user. Piraneo et al., for example, teaches that the slit pattern is selected to allow easy opening and removal of the article. Augst et al. teaches that when the spacing between perforations are too long it is difficult to separate and accidental and unintended separation is likely when the perforations are too short. The reference discussed the right tensile strength should be determined to prevent premature separation and sufficient reduction in tensile strength to ensure easy and consistent separation. Augst et al. achieved the result by considering various variable and test the variables. Finally, Kennedy is also cited to show that spacing between perforations is about 1.02mm.

Response to Arguments

6. Applicant's arguments filed on 7/29/04 have been fully considered but they are not persuasive. Applicant's argument concerning the citation of Leshin is not understood. The

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citation of the case law is applicable as an obviousness rejection in combination with the base references. The examiner is not required to provide additional evidence when this rejection has been applied. With respect to other arguments, the application of new references obviates over the arguments.

Conclusion

7. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The **Group clerical receptionist number is (703) 308-1148** or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**.


If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

For applicant's convenience, the official FAX number is (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

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Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST.

STL
September 22, 2004


Primary Examiner
Shian Luong
Art Unit 3728